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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91123312
Party	Plaintiff INTEL CORPORATION
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Date	03/10/2006
Attachments	Opposer'.pdf (7 pages) Declarat.pdf (2 pages)

INTEL CORPORATION,)	
)	
Opposer,)	Opposition No. 123,312
)	
v.)	Serial No.: 75/825,218
)	
STEVEN EMENY,)	Published: April 24, 2001
)	
Applicant.)	Opposed Mark: IDEAS INSIDE
)	
)	Classes: 35, 38 and 42
)	
)	

Opposer Intel Corporation (“Intel”) submits this reply brief in support of its Motion for Leave to Amend its Notice of Opposition. Intel also objects to Applicant’s improper, untimely, and incomplete submission of certain evidence with his response brief, as well as Applicant’s improper request to dismiss Intel’s Opposition.

I. Applicant's Response Supports Dismissal of Intel's Likelihood of Confusion and Dilution Claims.

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Instead, Applicant argues that because this matter has gone on for “six years,” there is no point in judicial economy at this stage. (Opp. at 2). It is beyond dispute that the parties and the Board will all conserve valuable resources if Intel’s Opposition focuses only on Applicant’s bona fide intent-to-use. Thus, aside from Applicant’s miscalculation of the length of this proceeding¹, this argument overlooks the fact that much of the Board’s involvement occurs after the parties complete their briefing.

Applicant also opposes Intel’s motion because “the lack of confusion and lack of dilution to the INTEL INSIDE mark *is a basis of the Applicant’s case.*” (Opp. at 2) (emphasis added). Applicant apparently misconstrues the nature of Intel’s motion, because dismissal of these claims – with or without prejudice – is to Applicant’s advantage (if he believes there is a lack of confusion or dilution), not detriment.

Applicant erroneously suggests that if he prevails against Intel on the likelihood of confusion or dilution grounds, then his application will register. (Opp. at 2-3). This is not the case. If the Board determines that Applicant lacked a bona fide intent to use the IDEAS INSIDE mark, that will be dispositive of Intel’s opposition. *Cf. American Paging Inc. v. American Mobilphone Inc.*, 13 U.S.P.Q. 2d 2036 (T.T.A.B. 1989), *aff’d without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990) (ruling on one dispositive ground renders other grounds for granting cancellation moot).

Intel also draws the Board’s attention to the fact that Applicant’s Opposition is focused on the dismissal of Intel’s likelihood of confusion and dilution claims *without* prejudice. Applicant does not challenge (or articulate a challenge) to dismissal of those claims *with* prejudice. (Opp. at 2) (Applicant’s brief seeks the Board to “deny the Intel

¹ Intel did not oppose the subject application until June 2001, which is approximately four and a half years ago, and much of this proceeding has been occupied by Applicant’s two defaults and subsequent attempts to set aside default.

Request to Amend its Opposition and Dismiss Without Prejudice the Infringement and Dilution Causes of Action.”) Applicant does not address Intel’s request that the Board, in the alternative, dismiss the claims with prejudice. Therefore, even if the Board does not believe that dismissal without prejudice would be proper (although Intel asserts that it would), Intel’s motion to amend *with* prejudice is both proper *and* uncontested by Applicant.

II. Opposer Objects to Applicant’s Exhibits M, N, O, and P as Untimely and as Lacking Foundation.

As part of his opposition, Applicant submitted new evidence that should be stricken from the record. *See, e.g., Starbucks U.S. Brands, LLC et. al. v. Ruben*, 2006 TTAB Lexis 54 (TTAB 2006) (granting motion to strike and excluding evidence attached to defendant’s trial brief as untimely since evidence was not previously introduced during testimony period). These include: 1) Exhibit M: excerpt from a Canadian Intellectual Property Office (CIPO) ruling; 2) Exhibit N: chart titled “Intel’s New Brand Architecture,” the source of which is not identified; and 3) Exhibits O & P: two articles for which no foundation has been laid. It is improper for Applicant to offer any such evidence at this stage of the proceeding since the testimony period is now closed. *Id.*; *see generally* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) 704 and 706. If Applicant wished to introduce these exhibits into evidence, the proper procedure would have been for Applicant to move to re-open his testimony period so that he could lay the proper foundation for the new evidence and put them on the record, but he did not do so.

Aside from the untimeliness and impropriety of those exhibits, they are irrelevant, incomplete, and lack any foundation. As Exhibit M, Applicant offered fragmented

portions of a CIPO ruling (pages 18-21). This evidence was never submitted in this proceeding by the parties and is not a part of the record. More egregiously, Applicant omitted over two-thirds of the opinion, including the basis for the CIPO's ruling and the fact that his home country's trademark office ruled that he lacked a bona fide intent to use the IDEAS INSIDE mark and granted Intel's opposition on that ground. (See Exh. M at pp. 21) (refusing IDEAS INSIDE application).

Exhibits N, O and P are also not a part of the record in this proceeding. Applicant has not identified the source of these exhibits, laid a proper foundation for them, or provided a declaration to explain where and how Applicant obtained them. Regardless, if Applicant's intention was to suggest that Intel has abandoned the INTEL INSIDE mark, that implication is both false and irrelevant on Intel's motion to amend.

For all of these reasons, Exhibits M - P should be stricken and not considered by the Board.

III. Applicant's "Request for Dismissal" Should be Denied as Untimely and Improper.

In his opposition, Applicant requested that the Board dismiss Intel's opposition. (Opp. at 3-5). This request is tantamount to a motion for summary judgment, and is untimely under the Rules. See TBMP 528.02 (motion for summary judgment should be filed before the opening of the first testimony period). As noted above, Applicant's allegations regarding the viability of Intel's marks are unsupported, incorrect, and uncorroborated by any testimony from the record (to the contrary, the record evidences

that Intel's cited registrations are all valid and subsisting). The Board should therefore deny Applicant's request for dismissal.²

IV. The Board Should Require Applicant to Take Further Steps to Ensure That There are no Delays in Service on Intel.

TBMP 502.02(b) contemplates that a movant should have fifteen days to review a response brief, investigate its allegations, and prepare and file a reply brief in a TTAB matter. Just so that this period is not shortened as a result of service by mail, the Board also gives the party an additional five days when service is by mail. 37 CFR § 2.119(c).

Here, Applicant stated that he served his response brief on opposer via "*overnight courier*" on February 15, 2006 when in fact, he served it by *air mail* from Canada which did not arrive at Intel's counsel's office until February 27, 2006. (Decl. of Yaghmai, filed concurrently herewith, at ¶¶1-2).³ This delay essentially cut Intel's response time in half. Given the issues raised by Applicant in his response brief, and because Intel submits this reply within the two week deadline contemplated by TBMP 502.02(b), the Board should consider Intel's brief timely.

In addition to Applicant's misstatement of the method of delivery, Applicant's certificate of service violates TBMP 113.03, which specifically requires that a certificate "specify the name of each party or person upon whom service was made, and the address." Here, Applicant's certificate only stated that the document was being served on "opposer," and no address for the service was provided. (Decl. of Yaghmai, ¶3)

Applicant should not be allowed to continue to take liberties with or to ignore the Board's rules because he is appearing *pro se*, especially when such conduct prejudices

² This is not the first time Applicant has inappropriately moved for judgment in this proceeding. He tersely sought summary judgment as part of his February 14, 2005 opposition to Intel's Summary Judgment motion. The Board did not even consider that request. See August 31, 2005 Order on Summary Judgment.

³ This was the same day the Board received Applicant's filed copy of the brief. (Decl. of Yaghmai, ¶ 4)

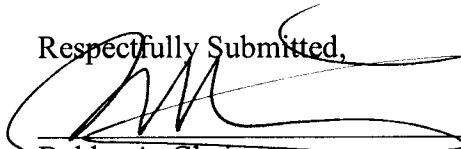
Intel. In order to prevent a similar delay in service in the future, especially with respect to the parties' Trial Briefs, Intel requests that the Board require that Applicant timely serve Intel's counsel at the address of record by overnight delivery or, alternatively, by mail and email.

V. Conclusion

Intel respectfully requests that the Board grant its motion to amend its notice of opposition to withdraw its infringement and dilution claims without prejudice. If the Board does not allow Intel to withdraw its claims without prejudice, it should permit Intel to withdraw its infringement and dilution claims with prejudice as uncontested. Finally, the Board should strike Exhibits M-P and deny Applicant's improper "request for dismissal."

Date: 3-10-06

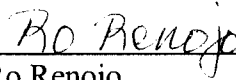
Respectfully Submitted,



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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing Intel's OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION; OBJECTION TO EXHIBITS ATTACHED TO APPLICANT'S BRIEF; AND RESPONSE TO APPLICANT'S REQUEST FOR DISMISSAL OF OPPOSITION and DECLARATION OF MIKE M. YAGHMAI were served on Mr. Steven Emeny, 93 Day Avenue, Toronto, Ontario M6E 3W4, Canada, by overnight courier, postage prepaid, this 10th day of March, 2006.



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Classes: 35, 38 and 42

Request for Suspension, and, Request by Applicant for Dismissal of Opposition” (“Applicant’s brief”) on February 27, 2006. Applicant’s brief arrived by air mail from Canada.

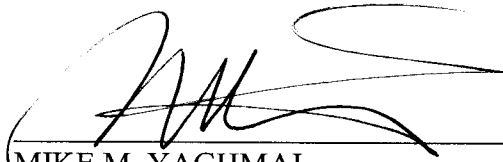
2. Our firm did not receive a copy of Applicant’s response brief by overnight courier as stated in Applicant’s certificate of service.

3. Applicant’s certificate of service stated that the brief was being served on “opposer” but no address of service was provided.

4. On March 2, 2006, I visited the TTABVUE website and reviewed the proceeding history for Opposition No. 123,312 relating to the mark IDEAS INSIDE and noticed that Applicant’s brief had just been posted on the site and indicated that it was received by the Board on February 27, 2006.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this 10th day of March, 2006 in East Palo Alto, California.


MIKE M. YAGHMAI